

Remarks/Arguments:

Claims 1, 3, 6, 13, 15, 16, and 18 are rejected by the Examiner under 35 U.S.C. 102(e) as being anticipated by Hansen (US 6,078,650). These rejections are respectfully overcome by the amendments to claims 1 and 13. In particular, Hansen does not disclose or suggest "a DTMF tone decoder which converts the DTMF tones to text matching respective individual keys on a telephone keypad," as required by claim 1. Claim 13 includes a similar recitation. Basis for this amendment may be found in paragraphs [0024] and [0030] of the subject application.

With respect to claim 1, the Examiner contends that "Hansen teaches a voice mail system that receives the audio message... converting the DTMF tones to text... a mailbox... [and] recording the audio message and the text corresponding to the DTMF tones into a mailbox", citing col. 6, lines 41-54 and col. 17, lines 32-43 of Hansen.

In col. 6, lines 41-54, Hansen describes existing voicemail systems in preferred embodiments of his invention as including:

"the ability for a caller to record an audio message and deliver the audio message to a specific mailbox... for the mailbox holder of the specific mailbox to listen to the audio message... [and] to indicate that the message is in the mailbox..."

It should be noted that the voicemail system disclosed is not an element of Hansen's invention. Rather, it has been described in order to illustrate preferred compatibility of his invention with "other phone systems... but other voice mail systems may be used in certain instances, so long as they have certain abilities and features [as described]" (col. 6, lines 33-38).

Further, in col. 17, lines 32-43, Hansen describes the invention as being able to "[use] predetermined phrases... sent from a standard telephone via text server 1220 to external TDD device 1205", further disclosing that the process in fig. 13

"illustrates a preferred process used to convert DTMF to text in order to establish real time communications via a text server from either the desktop or TDD device and a display telephone."

Also, fig. 13 discloses that the "system has a Database Table of DTMF to Text Conversion" that is used to convert the DTMF tones to respective predetermined words and phrases to be displayed on a display telephone or converted to audio speech. Thus, Hansen does not disclose or suggest converting "the DTMF tones to text matching respective individual keys on a telephone keypad."

The Applicant's invention, as defined by claim 1, describes an answering machine that is able to record and present audio messages that may include both audio and DTMF tones. Claim 1 has been amended to more clearly show that any DTMF tones detected are decoded into text that matches individual keys on a telephone keypad corresponding to the respective DTMF tones. That is to say that the present invention is able to record and present both audio messages and text representations of any telephone key strokes inputted by a user while leaving a message on the answering machine. This allows users leaving a message to also leave a phone number where they may be reached by striking each key on their keypad corresponding to their phone number. This is so that garbled speech, thick accents, background noise, etc. will not preclude the reception of a telephone number given by the user leaving a message.

It is obvious that the Hansen invention is directed to "TDD and/or TTY devices used by the deaf to communicate" (col. 1, lines 43-44) and not to an answering machine capable of recording and presenting messages containing audio as well as DTMF tones. Further, Hansen does not disclose or suggest that his invention may record or present both DTMF tones converted to text and speech, as required by claim 2, from which rejected claim 3 depends. In fact, it would be illogical to do so, since deaf individuals do not have the ability to use audio in telecommunications systems. Additionally, the present invention converts DTMF tones to text that matches individual keys on a telephone keypad corresponding to the respective DTMF tones detected, and not to predetermined words or phrases as disclosed by Hansen. Because it would not be logical to modify Hansen to meet the limitations of claim 3, claim 3 can not be

subject to rejection under 35 U.S.C. §§ 102 or 103 in view of Hansen for reasons independent of claim 1.

Therefore, it can be seen that the elements and functionality of the elements in the present invention, as embodied in claims 1 and 3, are neither disclosed nor suggested by Hansen. Thus, claim 1 is not subject to rejection under 35 U.S.C. 102(e) as being anticipated by Hansen. Further, claims 3 and 6 depend from claim 1 and are not subject to rejection for at least the same reasons as claim 1.

With respect to claim 13, the Examiner contends that "Hansen teaches receiving the audio message... converting the DTMF tones to text... [and] recording the audio message and the text corresponding to the DTMF tones into a mailbox".

Claim 13 has been amended to more clearly show that any DTMF tones detected are decoded into text that matches individual keys on a telephone keypad corresponding to the respective DTMF tones detected.

Thus, for the same reasons described above with respect to claim 1, it can be seen that the elements and functionality of the elements in the present invention, as embodied in claim 13, are also not disclosed or suggested by Hansen. Thus, claim 13 is not subject to rejection under 35 U.S.C. 102(e) as being anticipated by Hansen. Further, claims 15, 16 and 18 depend from claim 13 and are not subject to rejection for at least the same reasons as claim 13.

Claims 4, 5 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Hansen, McNutt et al. and Tverskoy et al. This ground for rejection is overcome by the amendments to claims 1 and 13, described above. In particular neither Hansen, McNutt et al., Tverskoy et al. nor their combination disclose or suggest "a DTMF tone decoder which converts the DTMF tones to text matching respective individual keys on a telephone keypad," as required by claim 1. Hansen is described above. McNutt et al. describe a message taking and retrieval system that employs a menu driven by DTMF tones entered by the user. (See Fig. 4). McNutt, however, does not disclose or suggest that the DTMF tones are converted into text matching individual keys on the telephone keypad. Similarly, Tverskoy et al. relates to an answering machine that records voice messages but, like McNutt et al. and Hansen, does not disclose or

suggest converting the DTMF tones into text matching keys on the telephone keypad. Because this limitation of claims 1 and 13 is neither disclosed nor suggested by any of Hansen, McNutt et al., Tverskoy et al. nor their combination, claims 4 and 5, which depend from claim 1 and claim 17, which depends from claim 13 are not subject to rejection under 35 U.S.C. § 103(a) in view of Hansen, McNutt et al. and Tverskoy et al.

Claims 7 and 12 were rejected under 35 U.S.C. § 103(a) as being obvious in view of Schindler et al. in view of Hansen. This ground for rejection is respectfully traversed.

With respect to claim 7, the Examiner contends that

"Schindler et al. teaches video driver... [and] audio processing circuit... [but] fails to teach 'a telecommunications unit, including an answering machine module that receives audio messages'... 'a DTMF tone decoder which converts DTMF tones in the received audio messages to text'... 'a storage device'... 'a processor which stores the received audio messages and the text corresponding to the DTMF tones into the storage device'... [and] further teaches playing audio output using the audio processing circuit for audio output... [and] displaying the data using video driver".

The Examiner further contends that elements not taught by Schindler et al. are disclosed by Hansen and "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Schindler to allow [for present invention in view of] Hansen."

Schindler et al. concerns a system with enhanced display of digital video. This patent discloses an entertainment system including components such as a VCR, amplified speakers, a CD jukebox, a home network, a satellite dish connection, etc. integrated through a personal computer. Thus Schindler et al. invention generally "relates to an interface for a multiple user home entertainment system, and in particular to the user interface for controlling operation of the system" (col. 1, lines 15-20) and not to a telephone answering system or message recording system.

Because the inventions of Schindler et al. and Hansen do not pertain to the same field of innovation, the only suggestion that would support the combination of both comes from Applicants' own disclosure. Furthermore, no rationale for combining Schindler et al. with Hansen has been provided by the Examiner. Thus, it can be seen that the Examiner has relied only upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. The Court has stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fritch*, 23 USPQ 2d 1780, 1783, 1784 (Fed.Cir. 1992).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.* (emphasis added)¹

Thus, claim 7 is not subject to rejection under 35 U.S.C. 103(a) as being unpatentable over Schindler et al. and in view of Hansen. Further, claim 12 depends from claim 7 and is not subject to rejection for at least the same reasons as claim 7.

Claims 8 and 9 were rejected under 35 U.S.C. § 103(a) as being obvious in view of Schindler et al., Hansen and McNutt et al. This ground for rejection is traversed for the same reason as described above. The combination of Schindler et al. with Hansen and McNutt et al. is improper because the only support for this combination comes from Applicant's own disclosure. Again, no rationale has been provided as to why the skilled person would combine Schindler et al. with either Hansen or McNutt et al. Thus, Applicant's disclosure is

¹ MPEP §706.02(j)

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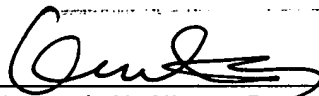
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impermissibly being used against him. Accordingly, claims 8 and 9 are not subject to rejection under 35 U.S.C. § 103(a) in view of Schindler et al., Hansen and McNutt et al.

Claims 10 and 11 were rejected under 35 U.S.C. § 103(a) as being obvious in view of Schindler et al., Hansen, McNutt et al. and Tverskoy et al. This ground for rejection is traversed for the same reason as described above. The combination of Schindler et al. with Hansen, McNutt et al. and Tverskoy et al. is improper because the only support for this combination comes from Applicant's own disclosure. No rationale has been provided as to why the skilled person would combine Schindler et al. with Hansen, McNutt et al. or Tverskoy et al. Thus, Applicant's disclosure is impermissibly being used against him. Accordingly, claims 10 and 11 are not subject to rejection under 35 U.S.C. § 103(a) in view of Schindler et al., Hansen, McNutt et al. and Tverskoy et al.

In light of the foregoing amendments and remarks, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1-18.

Respectfully submitted,


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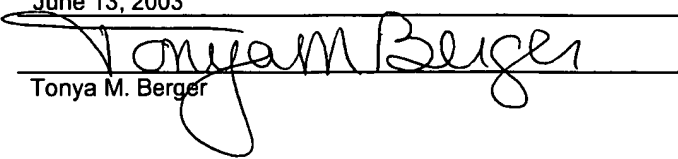
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